REMARKS/ARGUMENTS

The present invention is a toneable conduit that includes an elongate polymeric tube having a wall with an interior surface, an exterior surface, and a predetermined wall thickness; a channel extending longitudinally within the wall of the elongate polymeric tube; and a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from the channel. A continuous, high elongation wire is coincident with the channel in the elongate polymeric tube and coated with a coating composition that prevents the wire from adhering to the polymer melt used to form the polymeric tube. In addition, the high elongation wire is capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube to allow the conduit and wire to be coupled.

Claims 1 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sherlock (U.S. Patent No. 3,367,370) in view of Pelzer (U.S. Patent No. 5,212,349) and Nakamura et al. (JP 05106779). Claims 2-3, 5-6, 10-12 and 14 also stand rejected based on the combination of Sherlock, Pelzer and Nakamura, and further in view of one or more of the Pyramid Industries advertisement ("Pyramid"), Craton (U.S. Patent No. 6,139,957), Muschiatti (U.S. Patent No. 5,227,103), Levingston (U.S. Patent No. 6,105,649), Karl (U.S. Patent No. 6,135,159), Bird (U.S. Patent No. 6,131,265) and Tzeng (U.S. Patent No. 6,005,191).

The Office Action states that Sherlock discloses a toneable conduit but acknowledges that Sherlock fails to disclose a channel within the wall of the polymeric tube, a stabilizing rib extending longitudinally along the interior surface of the wall and located radially inward from said channel, and a continuous high elongation wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube to allow the conduit and wire to be coupled. The Office Action argues, however, that Pelzer teaches a channel 18 within the wall 16 of the polymeric tube 12 and that Figure 1 of Nakamura teaches a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube 1 and located radially inward from said channel.

Sherlock discloses a plastic pipe construction having metallic material of relatively high electrical or electronic conductivity and sensitivity secured to the pipe body that allows the pipe to be located underground. See Abstract of the Disclosure.

Pelzer discloses a method of inserting a detector wire into a cable duct by making a wire-receiving groove in a wall of the duct, laying the wire in the receiving groove, and leading a separate, softened filler material into the receiving groove and welding it to the duct wall to embed the detector wire in the duct wall. See Abstract of the Disclosure.

Nakamura discloses a buried pipe that can be detected underground. As set forth in the Abstract of Nakamura, a tubular cover body 2 is installed integrally on the outer peripheral surface of the pipe. The tubular cover body 2 includes a holding member 3 that forms a covered conductor holding part 8.

The combination of Sherlock, Pelzer and Nakamura does not teach or suggest the claimed invention. In particular, as acknowledged by the Examiner, Sherlock does not disclose a stabilizing rib extending longitudinally along the interior surface of the wall and located radially inward from said channel. Pelzer also does not disclose a stabilizing rib. Nakamura also fails to provide this teaching. In particular, although it appears that Nakamura might show ribs 5 in the figures, these ribs are not located radially inward from the channel 8 as recited in the claims. Instead, these ribs are provided at other locations on the interior of the tubular cover body. Accordingly, the combination of Sherlock, Pelzer and Nakamura does not teach or suggest the subject matter of the present claims.

Sherlock discloses toneable conduit

Nakamura's rib is also not provided on the interior surface of the wall of a toneable conduit as recited in the claims. Nakamura is directed to a tubular cover body for pipe. The ribs 5 in Nakamura appear to be used to provide a distance between the pipe and the tubular cover body, more than likely the facilitate installation of the cover around the pipe. The cited references provide no motivation for including ribs that are used on the interior of a tubular cover body as a stabilizing rib on the interior of a pipe, much less on the interior of a pipe at a location radially inward from a channel. Accordingly, the combination of Sherlock, Pelzer and Nakamura also does not teach or suggest the subject matter of the present claims for this reason.

Furthermore, Sherlock, Pelzer and Nakamura fail to teach or suggest a wire that is capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube and remaining continuous to allow the conduit and wire to be coupled. For example, Sherlock, Pelzer and Nakamura fail to disclose or suggest tearing a wire out of the polymeric tube to allow it to be coupled. Therefore, the claims are further patentable over the combination of Sherlock, Pelzer and Nakamura for this reason.

In re Hutchinson - capable of

It is noted that the Office Action argues that the language "capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube and remaining continuous to allow the conduit and wire to be coupled" does not constitute a claim limitation and cites *In re Hutchinson* to support this position (a copy of which is attached). In *Hutchinson*, the CCPA stated without explanation that the claim language "an article of manufacture, adapted for use in the fabrication of a metal template of the like suitable for metal-working operations" in the preamble of a claim did not constitute a limitation in a claim. The claim language "adapted for use" in *Hutchinson* is different than the "capable of" language of the present claims. In particular, "adapted for use," particularly when in the preamble of a claim as it was used in *Hutchinson* describes an intended use whereas "capable of" as used in the present claims describes a particular property. The phrase "capable of" has been used in other claims and interpreted by the Federal Circuit to be a claim limitation. See, e.g., *Plant Genetic Systems, N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 65 U.S.P.Q.2d 1452 (Fed.Cir. 2003). Accordingly, Applicants respectfully submit that the phrase "capable of" can be used to provide a claim limitation as it has in the present claims and that *Hutchinson* is not applicable to the present case.

The other secondary references, Pyramid, Craton, Muschiatti, Levingston, Karl, Bird and Tzeng, also fail to cure the deficiencies of Sherlock, Pelzer and Nakamura. For example, these references fail to teach or suggest a stabilizing rib extending longitudinally along the interior surface of the wall and located radially inward from said channel. Thus, Applicants respectfully submit that claims 1-14 are patentable over the cited references and respectfully request withdrawal of the rejections related to these claims.

Claim 30 stands rejected based on the combination of Wood (U.S. Patent No. 4,109,941) in view of Sherlock, Nakamura et al. and Pelzer. Claims 31-34 stand rejected over these references in further combination with Pyramid, Craton, Tzeng and/or Bird.

As discussed above, the combination of Sherlock, Pelzer and Nakamura fails to teach or suggest the claimed invention. For example, the combination of these references fails to teach or suggest a stabilizing rib extending longitudinally along the interior surface of the wall and located radially inward from said channel as recited in claims 30-34. Wood, Pyramid, Craton, Tzeng and Bird fail to cure the deficiencies of the teachings of Sherlock, Pelzer and Nakamura. Accordingly, it is respectfully submitted that claims 30-34 are patentable over the combination of Wood, Sherlock, Nakamura and Pelzer and respectfully request that the rejections based on these references be withdrawn.

Applicants respectfully submit that all the claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested in due course. If any minor informalities need to be addressed, the Examiner is directed to contact the undersigned attorney by telephone to facilitate prosecution of this case.

Consideration Of Previously Submitted Information Disclosure Statement

It is noted that an initialed copy of the PTO Form 1449 that was submitted with Applicants' Supplemental Citation Under 37 C.F.R. §1.97 filed April 18, 2003 was not returned to Applicants' representative with the Office Action. Accordingly, it is requested that an initialed copy of the Form 1449 be forwarded to the undersigned with the next communication from the PTO. Copies of the cited references were provided at the time of filing the original Information Disclosure Statement, and, therefore, no additional copies of the references are submitted herewith. Applicants will be pleased to provide additional copies of the references upon the Examiner's request if it proves difficult to locate the original references.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required

therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (703) 305-1341 on the date shown below.

Andrew T. Meunier — Date: August 7, 2003